

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL E. WHITCOMB

Appeal 2007-0024
Application 10/770,352
Technology Center 3600

Decided: July 11, 2007

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and CATHERINE Q. TIMM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

We hereby remand the above-identified application to the Examiner via the Office of the Director for Technology Center 3600 for action consistent with our comments below.

On May 4, 2006, the Examiner mailed an Examiner's Answer containing a new ground of rejection under the first paragraph of 35 U.S.C.

§ 112 (Answer 3). The new ground of rejection was approved by a designee of the technology center director (Answer 11).

On July 5, 2006, the Appellant responded to the new ground of rejection by filing a Reply Brief containing argument and evidence in opposition to the new rejection (Reply Br. 1-6 and 20).

On September 12, 2006, the Examiner responded to this Reply Brief only by stating that "[t]he Reply Brief filed 5/4/06 [sic, 7/5/06] has been acknowledged and entered."

This response by the Examiner is improper for multiple reasons.

First, the response fails to indicate whether the new rejection is maintained, and if so why, or whether the new rejection is withdrawn in light of the argument and evidence in the Reply Brief. See the Manual of Patent Examining Procedure (MPEP) § 1207.05(Rev. 3, Aug. 2005).

More importantly, the Examiner erroneously entered the Reply Brief and forwarded the application to the Board of Patent Appeals and Interferences for processing of the appeal. This is because the Reply Brief includes evidence as discussed above and therefore should have been treated as a request that prosecution be reopened. *Id.* at § 1207.03, part. V. Indeed, in making the new rejection, the Examiner expressly stated that a reply brief accompanied by evidence would be treated as a request that prosecution be reopened (Answer 10).

Under the foregoing circumstances, the Examiner must respond to this remand in one of the two following ways:

(1) If the new rejection is maintained, the Examiner must reopen prosecution in the manner provided by the MPEP § 1207.03.

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(2) If the new rejection is withdrawn, the Examiner must so inform the Appellant and return this application to the Board for processing the appeal as to the remaining rejections of record.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is **not** made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

REMAND

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Streets & Steele
13831 Northwest Freeway
Suite 355
Houston, TX 77040